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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,824	12/27/2001	Akihito Taguchi	011738	9857
38834	7590	01/24/2005	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			CANGIALOSI, SALVATORE A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,824

Applicant(s)

TAGUCHI ET AL.

Examiner

Salvatore Cangialosi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3621

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Purcell (5940807) or Tambay et al (20020026403A1) in view of O'Neill et al (6219653).

Regarding claim 1, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) disclose means for automated trading of bulk items including the determination of purchase price substantially as claimed. The differences between the above and the claimed invention is the use of a freight information utility. It is noted that it is believed that it would be obvious to include shipping costs in a purchase price. O'Neill et al (See abstract, Figs. 16 and 19, and claims 1, 12, and 22) show the calculation of freight in the execution of a sale trans

Art Unit: 3621

action . It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for either Purcell or Tambay et al because the ancillary sales transaction costs such as taxes and shipping are obvious functional equivalents with respect to the claim limitations in a sales transaction. Regarding product data limitations of claim 2, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show electronic shopping data in a browser which is a functional equivalent of the claim limitations. Regarding demand data limitations of claim 2, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor which is a functional equivalent of the claim limitations. Regarding evaluation limitations of claim 4, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor including credit risk evaluation which is a functional equivalent of the claim limitations. Regarding the client server limitations of claim 5, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping client server which is a functional equivalent of the claim limitations. Regarding claim 6, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3)

Art Unit: 3621

disclose means for automated trading of bulk items including the determination of purchase price substantially as claimed. The differences between the above and the claimed invention is the use of a position information utility. It is noted that it is believed that it freight is an obvious function of relative position. O'Neill et al (See abstract, Figs. 16 and 19, and claims 1, 12, and 22) show the calculation of freight in the execution of a sale transaction . It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for either Purcell or Tambay et al because the ancillary sales transaction costs such as taxes and shipping are obvious functional equivalents with respect to the claim limitations in a sales transaction. Regarding the freight limitations of claim 7, O'Neill et al (See abstract, Figs. 16 and 19, and claims 1, 12, and 22) show the calculation of freight in the execution of a sale transaction which is a functional equivalent of the claim limitations. Regarding demand data limitations of claim 8, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor which is a functional equivalent of the claim limitations. Regarding demand data limitations of claim 9, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor which is a functional equivalent of the claim limitations.

Art Unit: 3621

Regarding evaluation limitations of claim 10, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor including credit risk evaluation which is a functional equivalent of the claim limitations. Regarding the client server limitations of claim 11, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping client server which is a functional equivalent of the claim limitations. Regarding claim 12, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) disclose a method for automated trading of bulk items including the determination of purchase price substantially as claimed. The differences between the above and the claimed invention is the use of a freight information utility. It is noted that it is believed that it would be obvious to include shipping costs in a purchase price. O'Neill et al (See abstract, Figs. 16 and 19, and claims 1, 12, and 22) show the calculation of freight in the execution of a sale transaction. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for either Purcell or Tambay et al because the ancillary sales transaction costs such as taxes and shipping are obvious functional equivalents with respect to the claim limitations in a sales transaction. Regarding product data limitations of claim

Art Unit: 3621

13, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show electronic shopping data in a browser which is a functional equivalent of the claim limitations. Regarding demand data limitations of claim 14, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor which is a functional equivalent of the claim limitations. Regarding evaluation limitations of claim 15, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor including credit risk evaluation which is a functional equivalent of the claim limitations. Regarding program limitations of claim 16, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor that is implemented by software which is a functional equivalent of the claim limitations (Note claim 16 appears to be a program absent a medium). Regarding program limitations of claim 17, Purcell (See abstract, Figs. 1-3, Col. 4, lines 20-50, claims 1-17) or Tambay et al (See abstract, Figs. 2-5, pages 2-3) show an electronic shopping data processor that is implemented by software which is a functional equivalent of the claim limitations.

Art Unit: 3621

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts;
and

(2) whether the invention produces a useful, concrete, and tangible result.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, a program absent media is not statutory.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number (703) 305-1837. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can

Serial Number: 10/026,824

8

Art Unit: 3621

be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks

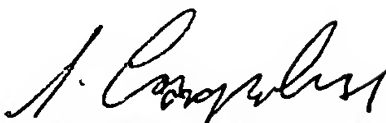
Washington, D.C. 20231

or faxed to (703)872-9306

Hand delivered responses should be brought to Crystal Park V, 2451 Crystal Drive, Arlington, Virginia, Seventh Floor(Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is (703) **308-4177**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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PRIMARY EXAMINER
ART UNIT 222